

wagering interface, and that presents a menu containing the set of menu options.

Sub. C3> 30. (Amended) A system for interactive wagering, comprising:

BS
lowl. a user input device that receives user inputs; and

control circuitry that receives the user inputs, selects wagering options based upon the user inputs, places a first wager using the wagering options; and presents wagering options as default selections in a subsequent wager entry process, wherein wagering options other than the default selections are available for selection in the subsequent wager entry process.

REMARKS

I. Introduction

Claims 1-30 were pending in the case. Claims 5, 14, 15, 20, 29, and 30 have been amended to more particularly define the features of applicants' invention. Claims 4 and 19 have been amended to correct typographical errors. These Remarks are followed by an Appendix showing how claims 4, 5, 14, 15, 19, 20, 29, and 30 have been amended.

The Examiner rejected claims 11-13 and 26-28 under 35 U.S.C. § 112 for failing to set forth the subject matter

which applicants regard as their invention. Claims 10, 14, 15, 25, 29 and 30 under 35 U.S.C. § 102(b) were rejected as being unpatentable over WO/97/09699 (hereinafter the "'699 publication"). Claims 5 and 20 were rejected under 35 U.S.C. § 102(a) as being anticipated by Prather et al. U.S. Patent No. 5,823,872 (hereinafter "Prather"). Claims 1-4 and 16-19 were rejected under 35 U.S.C. § 103(a) were rejected as being unpatentable over Massaro et al. U.S. Patent No. 5,535,321 (hereinafter "Massaro"). Claims 6-9 and 21-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of the '699 publication and Prather. The Examiner's rejections are respectfully traversed.

II. The Amendments to Claims 4 and 19

Applicants have amended claims 4 and 19 by replacing the word "transferring" with the word "transferring" in claim 4 and replacing the word "transferred" with the word "transferred" in claim 19. Therefore, applicants submit that these amendments are not substantial amendments related to patentability within the meaning of Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F. 3d 558, 56 USPQ 2d 1865 (Fed. Cir. 2000), but instead relate merely to matters of form.

III. The Claim Rejection Under 35 U.S.C. § 112

The Examiner rejected claims 11-13 and 26-28 under 35 U.S.C. § 112 for failing to set forth the subject matter which applicants regard as their invention. The Examiner's rejection is respectfully traversed.

The Examiner states that the structural limitations of applicants' claims 11-13 and 26-28 do not perform the function of a method for wagering because a user of a wagering system must be capable of placing a wager. In particular, the Examiner contends that the term "participant options" of independent claims 11 and 26 are not directed to options that would require the user to place a wager.

Contrary to the Examiner's contention, "participant options," such as horses, are required in order for a user to create and place a wager. Therefore, the structural limitations of claims 11 and 26 do support the wagering functionality of the claims.

Accordingly, for at least the foregoing reasons, claims 11 and 26 and dependent claims 12-13 and 27-28 fulfil the requirements of 35 U.S.C. § 112. Applicants respectfully request that Examiner's rejection of claims 11-13 and 26-28 be withdrawn.

IV. The Claim Rejections under 35 U.S.C. § 102(b)

The Examiner rejected claims 10, 14, 15, 25, 29 and 30 under 35 U.S.C. § 102(b) as being unpatentable over

the '699 publication. Applicants respectfully traverse the Examiner's rejection.

A. Claims 10 and 25

Applicants' independent claim 10 and analogous system claim 25 are directed towards providing a series of display screens, whereby each display screen includes user-selectable options for a particular user selection requirement. When the user places a wager by designating options for a series of user selection requirements, a simulated wager ticket is simultaneously displayed with each of the selected options.

The Examiner contends that FIGS. 35-39 of the '699 publication show the method (and system) of claims 10 and 25. The Examiner also contends that applicants' simulated wager ticket is merely a "summarization of the bet that the user is placing" and that the '699 publication discloses the simulated wager ticket in FIG. 39 and pages 25-26 of the '699 publication. Applicants respectfully submit neither FIG. 39 nor pages 25-26 of the '699 publication show a simulated wager ticket that is simultaneously displayed with each of the selected options when the user designates options through a series of displays.

The Examiner has mischaracterized applicants' simulated wager ticket as a mere summary of the user's

wager, which the Examiner contends is shown in FIG. 39 of the '699 publication. Applicants rebut the Examiner's contention. Applicants' simulated wager ticket is not merely a summary of the wager that can only be obtained after all user selection requirements have been selected, which is arguably shown by FIG. 39 of the '699 publication. Applicants' simulated wager ticket is a display of each of the user selected options provided simultaneously with a series of displays that includes user selectable options. Therefore, applicants respectfully submit that the Examiner has not shown that claims 10 and 25 have been in any way anticipated by the '699 publication and are therefore allowable over the '699 publication.

B. Claims 14 and 29

Applicants' independent method claim 14 and analogous system claim 29 are directed towards providing a set of menu options that is a function of the current operating mode, in response to user input. Applicants have amended claims 14 and 29 to define the meaning of "operating mode" to include an expert and a novice wagering interface. Thus, the Examiner's contention that the '699 publication discloses the features of claims 14 and 29 is incorrect because the '699 publication does not teach displaying menu options that are a function of selecting one of expert and novice wagering interfaces.

C. Claims 15 and 30

Applicants' independent method claim 15 and analogous system claim 30 are directed towards placing a wager based on selected wagering options and using these options as default selections in a subsequent wager entry process. Applicants have amended independent claims 15 and 30 to point out that wagering options other than the default selections are available for selection in the subsequent wager entry process.

Applicants rebut the Examiner's contention that claims 15 and 40 are anticipated by the '699 publication's description of a wager duplication process. The wager duplication process of the '699 publication teaches the duplication of an existing wager in a wager queue. When a wager is duplicated, the duplicate of the wager is then presented in the wager queue. Nowhere does the '699 publication teach presenting previously selected wagering options as default selections in a subsequent wager entry process, wherein wagering options other than the default selections are available for selection in the subsequent wager entry process as defined in claims 15 and 30. Accordingly, applicants respectfully submit that claims 15 and 30 are not anticipated by wager duplication as presented in the '699 publication.

In view of the foregoing, applicants respectfully submit that claims 10, 14, 15, 25, 29, and 30 are patentable over the '699 publication under 35 U.S.C. § 102(b), and request that the Examiner's rejections be withdrawn.

V. The Claim Rejection under 35 U.S.C. § 102(a)

The Examiner rejected claims 5 and 20 under 35 U.S.C. § 102(a) as being anticipated by Prather. Applicants respectfully traverse the Examiner's rejection.

Applicants have amended applicants' independent method claim 5 and analogous system claim 20. Amended claims 5 and 20 are directed towards a wager input interface having a plurality of types of user selection requirements displayed substantially aligned in a first dimension and a plurality of options corresponding to each type of user selection requirement displayed substantially aligned in a second dimension relative to the first dimension.

The Examiner relies solely on FIG. 8 of Prather in contending that Prather discloses every feature of applicants' claims 5 and 20. The Examiner states that the horses' names shown in FIG. 8 of Prather are user selection requirements. Assuming arguendo that horses' names are user selection requirements, FIG. 8 of Prather shows only one type of user selection requirement, and not the plurality of types of user selection requirements disclosed in applicants' claims 5 and 20.

Accordingly for at least the foregoing reasons, claims 5 and 20 are patentable over Prather under 35 U.S.C. § 102(a). Applicants request that the Examiner's rejection be withdrawn.

VI. The Claim Rejection Under 35 U.S.C. § 103(a)

A. Claims 1-4 and 16-19

The Examiner rejected claims 1-4 and 16-19 under 35 U.S.C. 103(a) as being unpatentable over Massaro.

Applicants respectfully traverse the Examiner's rejection.

Applicants' independent claims 1 and 16 are directed towards an interactive wagering system that receives user inputs and presents either an expert wager input interface or a novice wager input interface based upon these user inputs. The Examiner states that Massaro teaches a method and system for displaying an interface in which the user inputs the type of interface that is desired and is presented with that interface. The Examiner also states that Massaro does not present a wagering system or wagering interface *per se* but that Massaro's teachings can be used in any computer based interface system, including wagering systems and interfaces.

The Examiner has failed to make a *prima facie* case for rejecting applicants' claims on the basis of obviousness because any proposed modification to Massaro to provide expert and novice wager input interfaces would render

Massaro inoperable for its intended purpose. See MPEP § 2143.01. Massaro emphasizes that its intended purpose is to "provide an enhanced user interface which permits the automatic selection of variable complexity user interfaces for selected functions within a multiple function application." (Massaro, col. 1, lines 64-67). Applicants respectfully submit that if Massaro's teachings were modified to provide a computer based system that provided expert and novice wager input interfaces as defined in claims 1 and 16, the user could not select functions within the wager input interfaces in order to vary the complexity of the selected functions within the wager input interfaces.

The properties of the expert and novice wager input interfaces as disclosed in applicants' specification have to be considered by the Examiner in order to make a *prima facie* case for obviousness. See MPEP § 2141.02 and MPEP § 2111. Applicants' specification describes an expert wager interface that allows a wagerer to make all of the selections required to make a wager on a single screen and a novice wager input interface that allows a wagerer to make all of the same selections required to make a wager on a series of screens. See specification, page 29, line 6 to page 32, line 10. None of these disclosed properties of the novice and expert wager input interfaces in applicants' specification suggest that a user could select functions

within either novice or expert input interface in order to modify complexity of those selected functions.

Moreover, the Examiner has not provided the requisite motivation to modify Massaro to provide a novice and expert wager input interfaces in a wagering system. Rather, the Examiner has improperly looked to applicants' specification and asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Massaro to provide novice and expert wagering interfaces (see page 5 of the 2/21/01 Office Action).

Applicants respectfully submit that, absent applicants' specification and claims as a roadmap, persons skilled in the art would have no reason to modify Massaro to provide novice and expert wager input interfaces to achieve applicants' claimed invention. Applicants therefore respectfully submit that the requisite motivation is lacking from the rejection, and that the present rejection is based on impermissible hindsight reconstruction. In In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972), the court stated that in determining the propriety of the Patent Office case for obviousness, "it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination or other modification."

See ACS Hosp. Sys. Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1994) (the test for obviousness requires that the references, not the Examiner, provide teaching or suggestion supporting the combination of references offered); see In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990) (reversing the Board's obviousness rejection as a "classic example of hindsight reconstruction").

Accordingly, because the Examiner has improperly engaged in hindsight reconstruction, and because the absence of a suggestion to modify is dispositive in an obviousness determination, the Examiner's rejection is improper. Therefore, for at least these reasons, applicants respectfully request that the rejection of independent claims 1 and 16 and dependent claims 2-4 and 17-19 be withdrawn.

B. Claims 6-9 and 21-24

The Examiner has also rejected claims 6-9 and 21-24 under 35 U.S.C. 103(a) as being unpatentable over a combination of the '699 publication and Prather. Claims 6-9 and 21-24 depend on independent claims 5 and 20 respectively, which have been amended and are in condition for allowance. Therefore, applicants request that the Examiner's rejections be withdrawn.

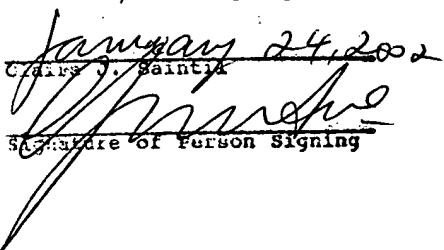
VII. Conclusion

In view of at least the foregoing reasons, applicants respectfully submit that independent claims 1, 5, 10, 14, 15, 16, 20, 25, 29, and 30 and dependent claims 2-4, 6-9, 11-13, 16-18, 21-24, and 26-28, are in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,


James A. Leiz
Registration No. 46,109
Agent for Applicants
FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1104
Tel.: (212) 596-9000

I hereby Certify that this
Correspondence is being
Deposited with the U.S.
Postal Service as First
Class Mail in an Envelope
Addressed to: ASSISTANT
COMMISSIONER FOR
PATENTS P.O. Box 22227
on
January 24, 2002
on
DANIEL J. SANTINI


Signature of Person Signing